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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,811	07/27/2000	Kotaro Oami	5000-4777	9671
27123	7590	06/27/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			RHEE, JANE J	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,811

Applicant(s)

OAMI ET AL.

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14, 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Repeated

1. The 35 U.S.C. 102(b) rejection of claims 7,10-11,13-14 anticipated by Gordon has been repeated for the reasons previously made on 12/14/2004.
2. The 35 U.S.C. 103(a) rejection of claims 8-9,12, over Gordon in view of Keng has been repeated for the reasons previously made on 12/14/2004.

New Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (4101701).

Gordon discloses a resin panel body (figure 5 number 26), an insert film (figure 5 numbers 18,16,24 combined) arranged on a surface of the resin panel body (figure 5 number 26), the insert film comprising a resin film (figure 5 number 24), a first binder layer formed on the surface of the resin film (figure 5 number 16), a printed part formed on the first binder layer (figure 5 number 12), a second binder layer formed so as to seal the printed part in co-operation with the first binder layer (figure 5 number 16) and the second binder layer contacting the first binder layer along a periphery of the printed part (figure 5 number 18, 16), wherein the first binder layer, the printed part and second

binder layer are formed in this order (figure 5 numbers 18,12,16); and wherein the printed part adheres to the first binder (figure 5 number 12). Gordon discloses that the printed part is a decorative pattern (col. 5 lines 47-48, figure 1 and figure 4).

Response to Arguments

4. Applicant's arguments filed 4/13/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Gordon fail to disclose that the printed part is formed on the first binder layer, the term "formed" is a product by process limitation. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Applicant argues that image 12 is supported by the support layer¹⁴, however, in col. 5 lines 47-48, Gordon discloses that both layers 12 and 14 are the color print layers, therefore neither one of the layers are supported by a support layer, hence the print layer is formed on the first binder layer.

In response to applicant's argument that Keng does not disclose that the printed part consist entirely of ink nor does the printed part directly adhere to the first binder layer and to the second binder layer, Gordon disclosed that the printed part consist entire of ink (col. 5 lines 47-48) and that the printed part directly adhere to the first

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binder and the second binder (figure 5 numbers 16,12,14,18). Keng teaches that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer (figure 2 number 14 and 19) or the second binder layer (figure 2 numbers 18,12) for the purpose of creating a laminate that provides protection to a document (col. 1 lines 50-53, col. 2 lines 43). Therefore, it would have been obvious to provide Gordon with the resin panel body that is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer or the second binder layer in order to create a laminate that provides protection to a document (col. 1 lines 50-53, col. 2 line 43) as taught by Keng.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

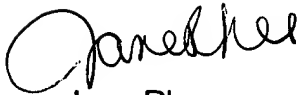
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jane Rhee
June 20, 2005



DAH-WEIYUAN
PRIMARY EXAMINER